

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-5, 9, 13, and 16-33 are pending in the application, with claims 1, 5, 9, 13, and 19 being the independent claims. Claims 1-5, 9, 13, 19, and 30-33 are sought to be amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Rejections Under 35 U.S.C. § 103***

Claims 1-5, 9, 13, and 16-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,742,905 to Pepe *et al.* (hereinafter "Pepe") in view of U.S. Patent No. 5,559,860 to Mizikovsky (hereinafter "Mizikovsky"). (See Office Action at p. 2.) Applicant respectfully traverses these rejections.

Amended independent claim 1 recites (emphasis added):

A system for receiving and forwarding e-mail messages for a subscriber, the system comprising:

    a server configured to be coupled to a network; and

    an agent resident and operable on the server, the agent configured to compare a first characteristic of the e-mail messages, received for the subscriber, to specific message characteristics provided by the subscriber and pre-stored on the server, to generate a message ID for an e-mail message that has a characteristic match, to send an alert message to the subscriber when the characteristic match is found, and to execute instructions for forwarding the e-mail message that has the characteristic match, wherein ***the first characteristic is other than message sender information, message subject line information,***

and message time information, the alert message includes the message ID, and the instructions are associated with the message ID and are received from the subscriber in response to the alert message.

Each of independent claims 5, 9, 13, and 19 has been amended in a similar manner. These features are supported throughout the specification of the present patent application including, for example, at the abstract, the paragraph from page 6, line 25 to page 7, line 12, and at line 110 of figure 1a, which states (emphasis by underlining added):

**The Mail Filter (also software on server 215) analyzes the Mail Copy (content of e-mail message), looking for Interest Criteria (in database on server 215).** When a *match is found*, an **Alert** is generated.

Neither Pepe nor Mizikovsky, alone or in combination, discloses, teaches, or suggests comparing a first characteristic of the e-mail messages to specific message characteristics provided by the subscriber and pre-stored on the server, wherein the first characteristic is other than message sender information, message subject line information, and message time information.

To the contrary, Pepe, at column 35, lines 43-51, recites (emphasis added):

If the user selected to edit the "subject" a screening criteria based on "subjects" by clicking box **658** (FIG. 35), a screen such as that illustrated in FIG. 37 is presented. The user may type in to boxes **678** particular subjects which should be routed according to a screening criteria. The subject will **search the incoming e-mail origination information to determine the subject of the e-mail**. Subjects may include "urgent", "personal", the name of a client or project, etc.

Mizikovsky does not overcome this deficiency.

Accordingly, each of independent claims 1, 5, 9, 13, and 19 is patentable over Pepe in view of Mizikovsky. Furthermore, because each of claims 2-4, 16-18, 20-33 depends upon claims 1, 5, 9, 13, or 19 and because of the individual distinctive features of each of claims 2-4, 16-18, 20-33, each of these claims is also patentable over Pepe in view of Mizikovsky.

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Therefore, Applicant respectfully requests that the Examiner reconsider claims 1-5, 9, 13, and 16-33, remove the rejections of these claims under 35 U.S.C. § 103(a), and pass these claims to allowance.

### ***Conclusion***

All of the stated grounds of rejection have been properly traversed. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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